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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,581

10/20/2003

Xavier Blin

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09/04/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KANTAMNENI, SHOBHA

ART UNIT

PAPER NUMBER

1617

NOTIFICATION DATE

DELIVERY MODE

09/04/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/687,581	Applicant(s) BLIN ET AL.	
	Examiner Shobha Kantamneni	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,26-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1, 3-17, 26-30, 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/18/2008 has been entered.

Applicant's amendment filed on 07/18/2008, canceled claim 2.

Claims 1, 3-17, 26-30, and 32 are examined herein as they read on the elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-17, 26-30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagrange (US 6,123,952, PTO-892 of record), in view of Clark et al. (WO 99/31081, PTO-1449).

Lagrange discloses cosmetic composition comprising organic photo chromic compounds in cosmetically acceptable oily phase. LaGrange discloses the organic

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photochromic compounds are compounds which have the property of changing color when they are irradiated with a light source and then regaining their initial color when the irradiation stops (column 1, lines 43-46). It is taught that the use of organic photochromic compounds in make-up or hair compositions gives novel coloring effects. See column 1, lines 6-10, lines 39-42. The composition can be in any cosmetically acceptable form, such as in the form of a lotion, suspension, dispersion or solution in aqueous-alcoholic or solvent medium, which may be multi-phasic; in the form of a gel, a mousse, a spray, an oil-in-water, water-in-oil or multiple emulsion; in the form of a free, compact or cast powder; in the form of an anhydrous solid or paste (column 3, lines 46-54). The photo chromic coloring agent is present in the amount of 0.05-30% by weight (column 6, lines 27-28). The composition also contains a cosmetically acceptable medium (column 6, lines 34-35). A fatty phase may be present comprising oils of animals, plants, mineral or synthetic origin, waxes of animal, plant, mineral, or synthetic origin, pasty fatty substances, gums, or mixtures thereof. See column 6, lines 46-52. Volatile oils may also be present, hydrocarbon based oils, such as isoparaffins, and in particular isododecane and fluoro oils. Non-volatile oils can also be used which can be polar or non-polar and include oils of animal, plant (such as castor oil), or mineral origin, and in particular animal or plant oils formed from fatty acid esters of polyols, in particular liquid triglycerides,. See column 6, line 54-column 7, lines 64. A face cream comprising oils in an amount of 20 % by weight is disclosed. See column 12, EXAMPLE 1. The cosmetic compositions therein are in the form of face cream, hair lotion, eyeshadow. See column 16-18, claims, 11-12, 20-21. The composition can also comprise a

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particulate phase, which can comprise pigments and/or pearlescent agents and/or fillers usually used in cosmetic compositions (column 10, lines 65-68). The fillers, which can be present, are in a proportion of from 0 to 30% by weight (column 11, lines 34-35). Pigments include white or colored, inorganic or organic particles intended to color or opacify the composition (column 11, lines 1-2), iridescent particles which reflect light (column 11, lines 8-9), and lakes and dyes (column 11, lines 16-25).

Lagrange does not disclose the employment of the particular instant photochromic organic dyes in the cosmetic composition therein.

Clark et al. disclose photochromic dyes, naphthopyrans of formula (I) or (II) which read on instant photochromic organic dyes. See abstract; pages 12-15, Examples 1-18; pages 25-27, claims 1-6. It is also taught that the photochromic dyes therein may be used to impart different colors to a solution, matrix or host material. See page 6, paragraph 2 from bottom.

It would have been obvious to a person of ordinary skill in the art at the time of invention to employ the photochromic compounds taught by Clark et al. in a cosmetic composition because Lagrange teaches that cosmetic compositions comprise photochromic organic dyes. One of ordinary skill in the art at the time of invention would have been motivated to employ the photochromic organic dyes taught by Clark et al. in a cosmetic composition with reasonable expectation of obtaining a make-up or hair compositions with desirable coloring effects.

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Furthermore, as the combined teachings of Lagrange and Clark et al., renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the “mean solubility parameter δ_a according to the Hansen solubility space, at 25 °C, of greater than or equal to $5.0 \text{ (J/cm}^3)^{1/2}$ “ as in claims 12, 13, and “mean solubility parameter δ_a according to the Hansen solubility space, at 25 °C, of less than $5.0 \text{ (J/cm}^3)^{1/2}$ “ as in claims 14-15, are the properties of the oils, and the properties are inseparable, since Lagrange teaches the same oils in the cosmetic composition therein. Further, the recitation “having a ΔE value of greater than or equal to 5” is the property of the composition, and as the combined teachings of Clark et al., and Lagrange renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings as discussed above. Therefore, if the prior art teaches the composition or renders the composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01.

Regarding the recitation “the organic dye is dissolved in the oily phase of the composition”, in claim 32 it is pointed out that the recitation is a product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art the claim is

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unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 ('Fed. Cir. 1985). See MPEP 21 13.

Response to Arguments

Applicant's arguments have been fully considered, but not found persuasive.

Applicant argues that "Lagrange states that his compositions contain only thermally irreversible photochromic compounds which are diarylethene derivatives, not naphthopyran compounds. Thus, Lagrange discloses very structurally different dye compounds. For at least this reason, Lagrange cannot teach or suggest the claimed composition." These arguments have been considered, but not found persuasive. It is pointed out that applicant is arguing against a single reference when the rejection was based on combination of references. Lagrange broadly teaches the use of organic photochromic compounds in make-up or hair compositions to give novel coloring effects, see column 1, lines 6-10, lines 39-42, line 63-column 2, line 3. LaGrange discloses that organic photochromic compounds are compounds which have the property of changing color when they are irradiated with a light source and then regaining their initial color when the irradiation stops (column 1, lines 43-46). It has been well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re

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Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). Lagrange broadly teaches the use of organic photochromic compounds in make-up or hair compositions to give novel coloring effects. Clark et al. disclose photochromic dyes, naphthopyrans of formula (I) or (II) which read on instant photochromic organic dyes. It would have been obvious to a person of ordinary skill in the art at the time of invention to employ the photochromic compounds taught by Clark et al. in a cosmetic composition because Lagrange teaches that cosmetic compositions comprise photochromic organic dyes.

Applicant argues that "Clark and Lagrange are not properly combinable. Clark's dyes are pH sensitive, and change color upon change in pH. In contrast, Lagrange's compositions are pH static -- they do not change pH. One skilled in the art, seeking to use Clark's pH-sensitive dyes, would not seek to place them in a pH-static environment like Lagrange's compositions where they would be unable to fulfill their purpose (changing color upon pH change)." These arguments have been considered, but not found persuasive because both Clark et al. and Lagrange references are analogues art pertaining to photochromic coloring agents, and are properly combined as discussed above. It is pointed out that Clark's dyes are photochromic / pH sensitive i.e they have photochromic and pH color switching properties. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of invention to employ the photochromic compounds taught by Clark et al. in a cosmetic composition because Lagrange teaches that cosmetic compositions comprise photochromic organic dyes.

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One of ordinary skill in the art at the time of invention would have been motivated to employ the photochromic organic dyes taught by Clark et al. in a cosmetic composition with reasonable expectation of obtaining a make-up or hair compositions with desirable coloring effects.

Prior Art Made of Record:

US 6,080,415.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Friday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D
Patent Examiner
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/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617